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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/552,313

09/11/2006

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298-303

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03/06/2009

EXAMINER

DONADO, FRANK E

ART UNIT

PAPER NUMBER

2617

MAIL DATE

DELIVERY MODE

03/06/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/552,313	Applicant(s) SCHWEIGER ET AL.	
	Examiner FRANK DONADO	Art Unit 2617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 December 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20, 22-26 and 28-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20, 22-26 and 28-36 is/are rejected.
- 7) ☒ Claim(s) 24 and 28-32 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

Art Unit Location

1. The Art Unit location of your application in the USPTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Art Unit 2617.
2. The amendment filed on 12/1/08 has been entered. Claims 1, 6, 13, 19, 20, 24 and 25 have been amended. Claims 21 and 27 have been cancelled. Claims 30-36 have been added. Claims 1-20, 22-26 and 28-36 are currently pending in this application, with claims 1 and 33 being independent.

Claim Objections

3. Claims 28-32 are objected to because of the following informalities: “**A method...**” should be changed to “**A communication system...**”, in accordance with claim 20. Appropriate correction is required. Claim 28 is also objected to because of the following informalities: “**...to the mobile device and from this to the module**” should be changed to “**...to the module within the mobile device**”, since the mobile device cannot forward information to itself. Appropriate correction is required.
4. Claim 24 is objected to because of the following informalities: “**...whether the identifier of a location area or radio cell coincides with a predetermined identifier first takes place**” is not a complete sentence. This claim is interpreted by the examiner as “**A method in accordance with claim 22, wherein said examination**

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whether the identifier of a location area or radio cell coincides with a predetermined identifier takes place first, followed by said examination of claim 22". Appropriate correction is required.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-17, 19-20, 22-25, 28, 30 and 33-34 are rejected under 35 U.S.C. 102(b) as being anticipated by Gallant, et al (**US Patent No. 5,802,468**). From now on, Gallant, et al, will be referred to as Gallant.

Regarding claim 1, Gallant teaches a communications system for mobile radio telephony, the system comprising: a plurality of mobile devices operable within a total territory of the communication system (**Calling areas are defined within a mobile communication system, where said communication system include a plurality of mobile stations operable within said communication system, Column 1, lines 7-10 and 67**), the total territory being divided into a plurality of location areas (**Said communication system is divided into a plurality of cells that define the current location of said mobile stations, Column 2, lines 32-39**), each mobile device

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comprising a module configured for insertion into the mobile device **(A Subscriber Identification Module (SIM) is inserted into said mobile station, Column 7, lines 32-37)**, the module facilitating unambiguous identification of the mobile device within the communications system **(Said SIM stores an identification code that defines the home geographic location for said mobile station that is used during a registration process of said mobile station, Column 7, lines 32-37 and Column 10, lines 19-28)**, each mobile device being associated with at least one subscriber territory being fixed inside the total territory covered by the communications system **(An identification code in said SIM defines the home geographic location for said mobile station used to define a home calling area, Column 7, lines 32-46)**, wherein the at least one subscriber territory includes at least a portion of at least one location area from among the plurality of location areas and wherein each mobile device is configured to determine whether it is located inside the at least one subscriber territory via determination means arranged on the module or via a remotely accessible determination unit **(Said home calling area overlaps said cells, and said mobile station uses SIM information to determine its location with respect to its home calling area, Column 7, lines 54-55 and Column 10, lines 19-31)**.

Regarding claim 2, Gallant teaches a communications system in accordance with claim 1, wherein the module is the subscriber identification module (SIM) **(Column 7, lines 32-37)**.

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Regarding claim 3, Gallant teaches a communications system in accordance with claim 1, wherein location areas in which one or more radio cells are located are arranged in the total territory covered by the communications system **(Said home calling areas that overlap with cells lie within said communication system, Column 7, lines 42-46).**

Regarding claim 4, Olds teaches a communications system in accordance with claim 3, wherein location areas and/or the radio cells have identity data characterizing them **(Said home calling areas are associated with an identification code, Column 7, lines 32-46).**

Regarding claim 5, Gallant teaches a communications system in accordance with claim 4, wherein the identity data include identifiers and coordinates **(Said home geographic location that is used to define said home calling area and is defined by said identification code in said SIM includes coordinate information, Column 10, lines 16-18).**

Regarding claim 6, Gallant teaches a communications system in accordance with claim 4, further comprising means for transmitting the identity data of the location areas and/or of the radio cells to the mobile devices **(Said mobile station receives and decodes coordinate identifier fields transmitted by a Base Transceiver Station (BTS) that control said cells, Column 10, lines 19-21 and Column 7, lines 54-55).**

Regarding claim 7, Gallant teaches a communications system in accordance with claim 1, wherein an interface is provided in the mobile devices by means of which the identity data can be transmitted to the module **(Cell identifier information is transmitted to the mobile unit, Column 10, lines 19-21 and Column 7, lines 54-55).**

Regarding claim 8, Gallant teaches a communications system in accordance with claim 1, wherein means are provided in the module and/or in the determination unit of the communications system by means of which the identity data of the location area or radio cell in which the mobile device is located can be compared with data characterizing the subscriber territory **(Said SIM identification code that defines the home geographic location for said mobile station during a registration process of said mobile station is compared against said Cell identifier information, Column 10, lines 19-31).**

Regarding claim 9, Gallant teaches a communications system in accordance with claim 8, wherein the data characterizing the subscriber territory include identifiers and coordinates of the locations areas and/or radio cells located in the subscriber territory **(Said home geographic location that is used to define said home calling area and is defined by said identification code in said SIM includes coordinate information, Column 10, lines 16-18).**

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Regarding claim 10, Gallant teaches a communications system in accordance with claim 8, wherein the data characterizing the subscriber territory are stored in the module and/or in the determination unit **(Said identification code that defines home calling area information is stored in said SIM, Column 7, lines 32-46).**

Regarding claim 11, Gallant teaches a communications system in accordance with claim 1, wherein the means by which it can be determined whether the mobile device is located inside the subscriber territory are designed such that it can be determined by them whether the coordinates of a location area or of a radio cell of the communications system are disposed in a region which is fixed by a location and the radius of a circle surrounding the location as a center **(Said home calling area is defined by a circular area with a radius, where said home calling area and its associated coordinates are used to determine whether mobile device is located inside home location, Column 7, lines 46-49, Column 10, lines 16-18 and Column 10, lines 25-28).**

Regarding claim 12, Gallant teaches a communications system in accordance with claim 11, wherein the coordinates of the location and the radius are stored in the module or in the determination unit **(Said coordinates of said geographical address of said mobile station used to define said radius are stored in said SIM, Column 10, lines 16-18 and Column 7, lines 42-49).**

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Regarding claim 13, Gallant teaches a communications system in accordance with claim 11, wherein the identifiers of the location areas and/or of the radio cells unambiguously identify the corresponding coordinates of the location area and/or of the radio cell to which they apply to facilitate a determination of the coordinates from the identifiers **(Both said cell identifiers and said identification codes that define home calling areas have corresponding coordinates, Column 10, lines 12-17 and Column 3, lines 23-26).**

Regarding claim 14, Gallant teaches a communication system in accordance with claim 13, wherein the identifiers of the location areas and/or of the radio cells are designated such that they are in an unambiguous relationship with the coordinates of the location area and/or of the radio cell so that the coordinates can be determined from the identifiers **(Both said cell identifiers and said identification codes that define home calling areas have corresponding coordinates and, as is commonly understood in the art, are uniquely different from one another, Column 10, lines 12-17 and Column 3, lines 23-26).**

Regarding claim 15, Gallant teaches a communications system in accordance with claim 1, wherein means are provided in the module or in the determination unit by which the coordinates can be determined on the basis of the identifiers **(Coordinates are associated with said identifiers of home calling areas, Column 3, lines 23-26).**

Regarding claim 16, Gallant teaches a communications system in accordance with claim 15, wherein the module and/or the determination unit has means by which it can be determined whether the identifier of a location area and/or of a radio cell coincides with a predetermined identifier of the location area and/or of the radio cell of the subscriber territory **(Said home calling area identification is predetermined and current cell area information is then determined from current cell ID information and compared within said SIM module, Column 7, lines 32-37 and Column 10, lines 19-31).**

Regarding claim 17, Gallant teaches a communications system in accordance with claim 16, wherein the predetermined identifier is stored in the module or in the determination unit **(Said identification code that defines home calling area information is stored in said SIM, Column 7, lines 32-46).**

Regarding claim 19, Gallant teaches a communications system in accordance with claim 1, wherein the system further comprises an interface between the mobile device and the module to facilitate the transmission of a control signal indicating whether the mobile device is located in a subscriber territory **(The mobile unit communicates with said BTS and the determination is made as to whether the mobile unit location is within its home calling area, Column 10, lines 19-31).**

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Regarding claim 20, Gallant teaches a communication system in accordance with claim 1, the system configured to perform a method of operating a communications system for mobile radio telephony **(Calling areas are defined within a mobile communication system, where said communication system include a plurality of mobile stations operable within said communication system, Column 1, lines 7-10 and 67)**, the communication system being divided into a plurality of location areas **(Said communication system is divided into a plurality of local calling areas that are larger than home calling areas, Column 7, lines 22-24)**, each location area including at least one radio cell **(Said communication system is divided into a plurality of cells that overlap with said home calling areas that are contained within said local calling areas, indicating local calling areas contain cells, Column 7, lines 54-55 and 60-63)**, the method comprising: assigning at least one subscriber territory to a mobile device, the subscriber territory being defined according to three parameters, a subscriber X-coordinate position, a subscriber Y-coordinate position and a subscriber radius R, the three parameters collectively defining a circular subscriber territory within a total territory of the communication system **(Said home geographic location that is used to define said home calling area and is defined by said identification code in said SIM includes coordinate and radius information, Column 7, lines 32-49 and Column 10, lines 16-18)**; receiving an X-coordinate position and a Y-coordinate position of one of said location areas or radio cells within the communication system at the mobile device **(Said mobile station receives and decodes coordinate identifier fields transmitted by a Base Transceiver Station (BTS) that control said cells,**

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Column 10, lines 19-21 and Column 7, lines 54-55); determining whether the received X-coordinate position and the received Y-coordinate position of one of said location areas or radio cells is disposed within the subscriber territory as defined by said subscriber X-coordinate position, said subscriber Y-coordinate position and subscriber radius R **(Said home calling area overlaps said cells, and said mobile station uses SIM information to determine its location with respect to its home calling area, Column 7, lines 54-55 and Column 10, lines 19-31);** and informing a subscriber of the mobile device that the subscriber is within the subscriber territory in the case where said determining step is true **(Result from said determination is sent accordingly, Column 10, lines 31-33).**

Regarding claim 22, Gallant teaches a communication system in accordance with claim 20, wherein the examination whether the coordinates of a location area and/or of a radio cell are disposed in a region which is fixed by a location and the radius of a circle surrounding the location as a center takes place by means of the module and/or of the determination unit **(Said determination occurs at SIM, Column 10, lines 19-31).**

Regarding claim 23, Gallant teaches a communication system in accordance with claim 1, wherein an examination whether the identifier of a location area or of a radio cell coincides with a predetermined identifier of a location area or of a radio cell takes place by means of the module and/or of the determination unit **(Comparisons of said**

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cell identifiers and said identifiers of home calling areas take place at the SIM, Column 10, lines 19-31).

Regarding claim 24, Gallant teaches a communication system in accordance with claim 22, wherein said examination whether the identifier of a location area or radio cell coincides with a predetermined identifier takes place first, followed by said examination of claim 22 **(The identifiers are decoded before a radius distance values is calculated, Column 10, lines 19-28).**

Regarding claim 25, Gallant teaches a communication system in accordance with claim 20, wherein the location and the radius of the region and/or the predetermined identifiers are stored in the module and/or in the determination unit **(Said predetermined identifiers of home calling areas are stored in said SIM, Column 7, lines 32-37 and 42-46).**

Regarding claim 28, Gallant teaches a method in accordance with claim 20, wherein the identifier of the location area and/or of the radio cell and/or their coordinates are forwarded by a transmitter and receiver station to the module within the mobile device. **(Said BTS transmits coordinate information to said SIM, Column 10, lines 19-21).**

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Regarding claim 30, Gallant teaches the communication system according to claim 20, wherein the assigning step further comprises storing the three parameters within a memory of the mobile device **(Said coordinates are stored in said SIM, Column 10, lines 16-18).**

Regarding claim 33, Gallant teaches a method of operating a communications system for mobile radio telephony, the communication system being divided into a plurality of location areas **(A communication system is divided into a plurality of local calling areas that are larger than home calling areas, Column 7, lines 22-24)**, each location area including at least one radio cell **(Said communication system is divided into a plurality of cells that overlap with said home calling areas that are contained within said local calling areas, indicating local calling areas contain cells, Column 7, lines 54-55 and 60-63)**, the method comprising: assigning at least one predetermined identifier to a mobile device defining at least one subscriber territory of the mobile device **(An identifier of a home calling area for a mobile station is predetermined, Column 7, lines 32-46)**; receiving, at the mobile device, an identifier of one of a location area or a radio cell within the communication system **(Said mobile station receives and decodes coordinate identifier fields transmitted by a Base Transceiver Station (BTS) that control said cells, Column 10, lines 19-21 and Column 7, lines 54-55)**; determining whether the predetermined identifier matches the received identifier **(Comparisons of said cell identifiers and said identifiers of home calling areas take place, Column 10, lines 19-31)**; and

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informing a subscriber of the mobile device that the subscriber is within the subscriber territory in the case where said determining step is true **(Result from said determination is sent accordingly, Column 10, lines 31-33).**

Regarding claim 34, Gallant teaches the method according to claim 33, wherein the assigning step further comprises storing the predetermined identifier within a module of the mobile device **(Said predetermined identifiers of home calling areas are stored in said SIM, Column 7, lines 32-37 and 42-46).**

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

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9. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

10. Claims 18, 26, 29, 31-32 and 35-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gallant, in view of Olds (**US Patent No. 5,905,957**).

Regarding claim 18, Gallant teaches a communications system in accordance with claim 1. Gallant does not teach the identifiers stored in the determination unit are at least partly stored in a form reducing the storage requirements. Olds teaches the identifiers stored in the determination unit are at least partly stored in a form reducing the storage requirements (**The manner in which the service area information is stored in a Subscriber Information Manager (SIM) helps reduce the amount of faulty registrations, Column 9, lines 41-44 and 48-55**). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Gallant to include this feature in the Subscriber Identity Module for the benefit of cost savings.

Regarding claim 26, Gallant teaches a method in accordance with claim 25. Gallant does not teach the predetermined identifiers are at least partly stored in a manner reducing the memory requirements in the module and/or in the determination unit. Olds teaches the predetermined identifiers are at least partly stored in a manner reducing the memory requirements in the module and/or in the determination unit **(The manner in which the service area information is stored in the SIM helps reduce the amount of faulty registrations, Column 9, lines 41-44 and 48-55)**. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Gallant to include this feature in the Subscriber Identity Module for the benefit of cost savings.

Regarding claim 29, Gallant, in view of Olds, teaches a method in accordance with claim 28. Olds further teaches the data forwarded from the mobile device to the module are transmitted from this to the determination unit **(During registration with a Switching Office that did not handle a previous registration, the Switching Office will request mobile unit information from the SIM, Column 13, lines 54-56 and 61-65)**; and in that the determination unit--after an examination whether the mobile device is located in a subscriber territory--forwards the result to the mobile device and the latter to the module **(The registration process request allows for routing of a request message to an appropriate Switching Office, after which known location data are transmitted to the mobile unit and subsequently back to the control**

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station so the known location may be recorded in the SIM, Column 13, lines 54-56, Column 14, lines 18-20 and Column 4, lines 27-31 and 48-52).

Regarding claim 31, Gallant teaches the method according to claim 20. Gallant does not teach the assigning step further comprises storing the three parameters within a determination unit, remote from the mobile device. Olds teaches the assigning step further comprises storing the three parameters within a determination unit, remote from the mobile device **(A home SIM remotely located from the mobile device stores location information related to the area assigned to the mobile device, Column 4, lines 24-34 and Figure 1)**. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Gallant to assign this information to a remote determination unit for the benefit of good customer service and proper billing.

Regarding claim 32, Gallant teaches the method according to claim 20. Gallant does not teach the determining step further comprises: forwarding the X-coordinate position and Y-coordinate positions of one of said location areas or radio cells within the communication system from the mobile device to a determination unit; and determining, at said determination unit, whether the mobile device is disposed within the at least one subscriber territory based on a comparison of the received X-coordinate position and Y-coordinate positions of one of said location areas or radio cells. Olds teaches the determining step further comprises: forwarding the X-coordinate position and Y-

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coordinate positions of one of said location areas or radio cells within the communication system from the mobile device to a determination unit (**During registration, a mobile station resolves its own geographic position before forwarding said geographic position, which is also known as “known location”, over to a control station, where said registration is performed at control station, Column 8, lines 17-24, 43-46 and 62-67**); and determining, at said determination unit, whether the mobile device is disposed within the at least one subscriber territory based on a comparison of the received X-coordinate position and Y-coordinate positions of one of said location areas or radio cells (**Known location defines a target area, and said target area is compared against service area location to determine if said mobile station is within their service area, Column 11, lines 19-37**). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Gallant to forward the coordinate information to a determination unit to make the comparison determination during the registration process of a mobile device for the benefit of good customer service and proper billing.

Regarding claim 35, Gallant teaches the method according to claim 33. Gallant does not teach the assigning step further comprises storing the predetermined identifier within a determination unit, remote from the mobile device. Olds teaches the assigning step further comprises storing the predetermined identifier within a determination unit, remote from the mobile device (**A home SIM remotely located from the mobile device stores location information related to the area assigned to the mobile**

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device, Column 4, lines 24-34 and Figure 1). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Gallant to assign this information to a remote determination unit for the benefit of good customer service and proper billing.

Regarding claim 36, Gallant teaches the method according to claim 33, wherein the determination of whether or not a mobile unit is located in their service area includes forwarding a determination result from the determination unit to the mobile device and informing a subscriber of the mobile device that the subscriber is within the subscriber territory in the case where said determination result is positive (**Column 10, lines 25-33**). Gallant does not teach the determining step further comprises: forwarding the received identifier from the mobile device to a determination unit; determining, at said determination unit, whether the mobile device is disposed within the at least one subscriber territory based on a comparison of the received identifier with the predetermined identifier of the mobile device. Olds teaches the determining step further comprises: forwarding the received identifier from the mobile device to a determination unit (**During registration, a mobile station resolves its own geographic position before forwarding said geographic position, which is also known as “known location”, over to a control station, where said registration is performed at control station, Column 8, lines 17-24, 43-46 and 62-67**); determining, at said determination unit, whether the mobile device is disposed within the at least one subscriber territory based on a comparison of the received identifier with the

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predetermined identifier of the mobile device **(Known location defines a target area, and said target area is compared against service area location to determine if said mobile station is within their service area, Column 11, lines 19-37)**. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Gallant to forward the coordinate information to a determination unit to make the comparison determination during the registration process of a mobile device for the benefit of good customer service and proper billing.

Response to Arguments

12. Applicant's arguments regarding claims 1 and 20, filed 12/1/08, have been fully considered but they are not persuasive for the following reasons:

In response to applicant's arguments regarding a SIM that is a module being inserted into the mobile device and the mobile device not determining whether the mobile device is located inside the at least one subscriber territory, wherein the determination means are arranged in one of the module or in a remotely accessible determination unit and Olds failing to disclose or suggest the specific combination of claim 20 have not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the

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process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

13. Applicant's arguments with respect to claims 2-19, 22-26 and 28-29 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to FRANK DONADO whose telephone number is (571) 270-5361. The examiner can normally be reached Monday-Friday, 9:30 am-6 pm, EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rafael Perez-Gutierrez can be reached on 571-272-7915. The fax phone number for the organization where this application or proceeding is assigned is 571-270-6361.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-273-8300.

Frank Donado
Art Unit 2617

/Rafael Pérez-Gutiérrez/

Supervisory Patent Examiner, Art Unit 2617

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